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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,498	09/12/2003	Olivier Bernard	004501-739	5621

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EXAMINER

TRIEU, THAI BA

ART UNIT PAPER NUMBER

3748

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/660,498

Applicant(s)

BERNARD, OLIVIER

Examiner

Thai-Ba Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1-4 is/are allowed.  
6) ☒ Claim(s) 4, 7, 8 and 10 is/are rejected.  
7) ☒ Claim(s) 6 and 9 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/20/2005.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

The Preliminary Amendment filed on September 12, 2003 is acknowledged. Applicant's cooperation in correcting the informalities in the drawing and specification are appreciated. Applicant's cooperation in amending the claims to overcome the claim objections relating to informalities as well as indefinite claim language is also appreciated. Applicant's arguments, see Pages 8-11, filed April 20, 2005, with respect to the rejection(s) of claim(s) 1-10, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is set forth below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claims 5, 8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hitomi (Patent Number 4,774,812).***

**Regarding claim 5,** Hitomi discloses a device for operating an exhaust gas turbocharger (11, 11a, 11b), in which a compressor (11b) of the exhaust gas turbocharger (11a) is flow-connected upstream to an intake line (8) and downstream to a compressor line (13), and the compressor line (13) is connectable to an intake duct (8) of an internal combustion engine (1) to form flow line, a throttle valve (16) being

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provided in the flow line, comprising a bypass line (18) a first side of said bypass line being connected on to the intake line upstream of a compressing element of the compressor (wheel/component in 11a) and with a second side of said bypass line being connected to the flow line downstream of the compressing element (wheel/component in 11a) of the compressor (11a), wherein in the assembled state of the downstream-compressing element (wheel/component in 11a) of the compressor (11a), the bypass line (18) is connected to the flow line (8) between the compressing element (wheel/component in 11a) and the throttle valve (16), and in that said bypass line (18) has at least one regulating element (20a) which is designed such a way that it allows only flow around the compressing element (wheel/component in 11a) from its side located upstream to its side located downstream and prevents a flow from the downstream side of the compressing element (wheel/component in 11a) to the upstream side of the latter (See Figures 1 and 8, Column 2, lines 31-40, Column 4, lines 15-30).

**Regarding claims 8 and 10,** Hitomi discloses an exhaust gas turbocharger (11, 11a, 11b) for charging an internal combustion engine, comprising a compressor (11a) which is flow-connected upstream to an intake line (8) and downstream to compressor line (13), the compressor line (13) being connectable an intake duct of an internal combustion engine to form a flow line, and a throttle valve (16) being provided in the flow line, comprising a bypass line (18) a first side of said bypass line connected to the intake line upstream of the compressor (11a) and a second side of said bypass line

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being connected to the flow line downstream of the compressor (11a), wherein the bypass line (18) is connected to the compressor line (13) between a compressing element (wheel/component in 11a) of the compressor (11a) and the throttle valve (16) and wherein said bypass line (18) has at least one regulating element (20a) which is designed in such a way to allow only a flow around the compressing element (wheel/component in 11a) from an upstream side located of the compressor element (wheel/component in 11a) and to prevent a flow from the downstream side of the compressing element (wheel/component in 11a) to the upstream side of the latter (See Figures 1 and 8, Column 2, lines 31-40, Column 4, lines 15-30).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hitomi (Patent Number 4,774,812), in view of Finger et al. (Pub. Number US 2003/0115870 A1).***

Hitomi discloses the invention as recited above, however Matsumura fails to disclose the bypass line being integrated into a turbocharger casing.

Finger teaches that it is conventional in the exhaust gas turbocharger art, to utilize the bypass line (15) being integrated into a turbocharger casing (9) (See Figure 1).

It would have been obvious to one having ordinary skill in the art at that time the invention was made, to have utilized the bypass line being integrated into a turbocharger casing, as taught by Finger, since the use thereof would have saved the space in the Hitomi device.

#### ***Allowable Subject Matter***

Claims 1-4 are allowed.

Claims 6 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant's arguments with respect to claim 1-10 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

The IDS (PTO-1449) filed on April 20, 2005 has been considered. An initialized copy is attached hereto.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Adrian (US Patent Number 6,722,128 B1) discloses a blow-off valve.
- Hitomi et al. (Pub. Number JP 01-092524 A) disclose a scavenging device for engine provided with supercharger.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTB  
January 14, 2005

  
Thai-Ba Trieu  
Primary Examiner  
Art Unit 3748